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Elizabeth Miller  
Elizabeth Miller

Sept. 17, 2001  
Date



ATTY DOCKET No. 10991572-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: J. Robert Mitchell

Group Art Unit: 1743

Serial No.: 09/426,111

Examiner: P. Kathryn Bex

Filed: October 22, 1999

Title: FLUIDIC STRUCTURES WITHIN AN ARRAY PACKAGE

Commissioner for Patents  
Washington, D.C. 20231

REC-  
SEP 26 2001  
TC 1700

Dear Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the restriction requirement in the Office Action mailed 08/16/01, Applicant elects Group I (claims 1-11, 29-32 and 42-44) with traverse.

Applicant reminds the Examiner that in making the restriction requirement between the identified Groups the Examiner, at least implicitly, is taking the position that each identified Group is patentable over the other. This is so since for any restriction MPEP 802.01 requires that each of the subjects of the restriction must be "PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)".

The Examiner states that Group I is a "method and package with a single inlet port". Applicant notes that the claim language is not restricted to a single inlet port.

The Examiner first takes the position that Groups I and III are unrelated and refers to the method claims in each Group for the proposition that the claims have different modes of operation. However, in claim 29 fluid is added or removed

through the first port such that fluid flow is directed by the fluid distribution channels between multiple different regions across the first side of the substrate to or from the first port. In claim 33 the wash fluid complies with this requirement in that it is added through the first port and directed by the fluid distribution channels in a similar manner. Therefore, the modes of operation of claims 29 and 33 are not different (although claim 33 has features additional to this common mode of operation). Accordingly, it is submitted this restriction between Groups I and III should be withdrawn.

Group I  
does not  
require  
2nd port

With regard to Groups III and II the Examiner takes the position that these are related as combination and subcombination. In formulating this position the Examiner states that the subcombination (Group II) "has separate utility such as a housing for a multi-well plate". However, MPEP 806.05(c) upon which the Examiner relies, requires a showing by the Examiner of separate utility. Assuming the correctness of the Examiner's assertion of using Group II as a housing for a multi-well plate, the Examiner provides no explanation why the presence of an additional port and fluid distribution channels (see claim 21 of Group II) prevents using Group III for the same alleged utility. Accordingly, there is no showing of a separate utility as required by MPEP 806.05(c), and this restriction should be withdrawn.

With regard to Groups II and I, the Examiner asserts that "This relationship..." (Groups III and II) "is also applicable to Groups II and I". Thus, the Examiner is saying that the subcombination (now Group I) can be used as a housing for a multi-well plate but Group II cannot. This position is exactly the opposite of, and therefore inconsistent with, the position the Examiner takes with regard to Groups III and II (wherein the Examiner's position is that Group II could not be used for a multi-well plate). Accordingly, if the Examiner maintains the restriction between Groups III and II then at the very least, for consistency with the Examiner's own argument, the restriction between Groups II and I should be withdrawn.

the apparatus  
of  
Group I  
does  
not  
require  
2nd  
port  
on a side  
it flows it  
when first  
it...

If the Examiner believes there are any outstanding issues which might be resolved by means of a telephone conference, she is invited to call Gordon Stewart at (650)485-2386.

Respectfully submitted,



Gordon Stewart  
Attorney for Applicants  
Reg. No. 30,528

Agilent Technologies, Inc.  
Legal Department, DL429  
IP Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

10991572-1 1<sup>st</sup> Response (Restn)

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): J. Robert Mitchell

Serial No.: 09/426,111

Filing Date: Oct. 22, 1999

Title: Fluidic Structures Within An Array Package

Examiner: P. Kathryn Bex

Group Art Unit: 1743

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee (Address envelope to "Box Non-Fee Amendments")  
( ) Other: \_\_\_\_\_ (fee \$ \_\_\_\_\_)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$80	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$270	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$390.00	3RD MONTH \$890.00	4TH MONTH \$1390.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: **Sept. 17, 2001**

Typed Name: **Elizabeth Miller**

Signature: Elizabeth Miller

Respectfully submitted,

**J. Robert Mitchell**

By Gordon M. Stewart

**Gordon M. Stewart**

Attorney/Agent for Applicant(s)  
Reg. No. **30,528**

Date: **Sept. 17, 2001**